

REMARKS

Item 22 of the Office Action dated May 28, 2003 characterizes that action as final, in violation of accepted Patent Office standards, MPEP 706.07(a) (“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**), and the finality of the current Office Action cannot be sustained.

Item 22 alleges that the new ground for rejection was necessitated by the applicants’ “amendments filed on 12/30/02 and 05/02/03.” Applicants traverse this proposition.

Claim 1 as original filed recited “. . . making selections from the units of primary information . . . and personalizing means for deriving personalizing information from said selections . . .”

The 9/24/02 Office Action rejected claim 1 as anticipated by International Publication No. WO 97/22062 to Huffman et al. (“Huffman”), and also rejected claim 1 as indefinite.

On 12/24/02, the applicants amended to overcome the indefiniteness rejection, but retained the above claim limitations.

The 3/18/03 Office Action rejected claim 1 as obvious over Huffman and retained the indefiniteness rejection.

On 05/06/03, the applicants amended the above limitation by adding a term only to overcome the indefiniteness rejection, the term having no relevance to overcoming prior art. The applicants presented a convincing argument that the limitation is neither anticipated nor made obvious by Huffman.

The present Office Action reverts back to the anticipation rejection and, in addition, introduces a new ground of rejection based on a newly introduced reference, U.S. Patent No. 5,726,688 to Siefert et al. ("Siefert").

The new ground of rejection introduced by the Examiner was not necessitated by the applicants' amendment. To the contrary, the new ground of rejection was necessitated by the persuasiveness of the remarks in the 05/06/03 amendment.

Reconsideration and withdrawal of the finality of the current rejection is respectfully requested, to avoid the need for the applicants to take further measures within the Patent Office.

The current Office Action has been reviewed and carefully considered. Claims 12-14 have been added. Claims 1-14 are pending in this case, with claims 1, 6 and 8 being the independent claims. Claim 1 has not been amended. Claims 6 and 8 have been amended to incorporate the limitations of claim 4 and claim 2 from which claim 4 depends. The Examiner's indication in item 18 of allowable subject matter for claims 4 and 5 is appreciated. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1, 6 and 8 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by Siefert.

Claim 1 recites “An information processing device comprising: a first storage device . . . a second storage device.”

Item 5 of the Office Action suggests that the “first storage device” of claim 1 of the present invention is disclosed as utilized in a Siefert embodiment that maintains data on which options are preferred in general by users of a computer. Item 5 suggests that the “second storage device” of claim 1 of the present invention is disclosed in Siefert, but fails to specify which, if any, Siefert embodiment utilizes the purported “second storage device.”

Siefert fails to disclose or suggest that any of its embodiments are combined with each other in forming said “information processing device” recited in claim 1. Moreover, even if such combination were deemed to be disclosed or suggested, Siefert fails to disclose or suggest implementation of more than one storage device to accommodate multiple embodiments that have been combined. In particular, the reference fails to disclose “An information processing device comprising: a first storage device . . . a second storage device” as explicitly recited in claim 1. For at least these reasons, Siefert fails to anticipate the invention as recited in claim 1.

Claims 6 and 8 have both been amended to incorporate the subject matter of claim 4 and claim 2 from which claim 4 depends. Since the current Office Action deems the subject matter of claim 4 allowable, claims 6 and 8 as amended are likewise believed to be patentable for at least the same reasons.

Claims 6 and 8 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 6,498,797 to Anerousis et al. (“Anerousis”). Claims 6 and

8 as amended incorporate the subject matter of claim 4, which has been deemed by the Examiner to be patentable, and are likewise patentable.

As to claims 1-3 and 6-11, the Examiner has reverted back to the anticipation rejection based on Huffman. Accordingly, claims 1-3 and 6-11 stand rejected under 35 U.S.C. 102(e) as allegedly anticipated by Huffman.

Item 21 of the Office Action implicitly acknowledges the shortcomings of the prior art of record by explicitly ignoring a term in claim 1.

Item 21 offers the following explanation “ . . . there is nothing in applicant’s disclosure that clearly defines personalizing information. Therefore, any information selected or derived from a stored record can be considered as personalizing information. Accordingly, Huffman is a relevant prior art reference.”

This proposition conflicts with Patent Office procedure.

The "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) MPEP 2111.

“When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art.” *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms) MPEP 2111.01.

In particular, the Office Action chooses to ignore the phrase “personalizing information.” This phrase finds clear support throughout the specification (e.g., page 4, lines 1-26), and would have been understood by those of ordinary skill in the art.

Claim 1 recites:

“An information processing device comprising:

a first storage device for storing units of primary information;

a user operable interface for making selections from the stored units of primary information to be processed and/or from functions to be invoked;

a second storage device; and

a personalizing means for deriving personalizing information from said selections in order to store the personalizing information in the second storage device.”

Firstly and in particular, Huffman fails to disclose “deriving personalizing information from said selections.” At best, Huffman can be described as making personal selections from stored units, and then displaying the selected units, but fails to disclose “deriving personalizing information from said selections.” Accordingly, for at least this reason, Huffman fails to anticipate the invention as recited in claim 1. This applies as well to claims 6 and 8, which also recite “deriving personalizing information from said selections.”

Secondly, Huffman fails to disclose “deriving personalizing information . . . in order to store the personalizing information in the second storage device.” The inventive aspect is described in the specification (e.g., page 4, lines 1-26). Item 12 of the Office Action suggests that, in FIG. 39 of Huffman, memory 760 is the “first storage device” of claim 1 and non-volatile memory 768 is the “second storage device” of claim

1. However, memory 760 stores the user's writing into an electronic book diary, and memory 768 stores an electronic dictionary utilized in compressing the user's inputs. The reference fails to disclose "deriving personalizing information . . . in order to store the personalizing information in the second storage device" as explicitly recited in claim 1. For at least this reason too, the reference fails to anticipate claim 1.

Each of the remaining claims depends from one of the base claims, and is deemed to be patentable over the reference for at least the same reasons.

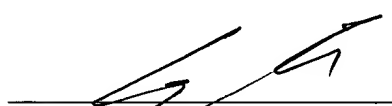
Claims 12-14 have been added to further emphasize inventive aspects that distinguish over the prior art of record. Support for the new claims is found in the specification (page 3, lines 16-18; page 4, lines 3-11).

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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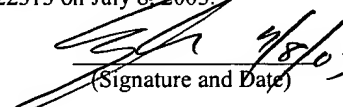
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(Signature and Date) 7/8/03